REMARKS

Applicants would like to thank the Examiner for careful consideration of this application. Claims 1-15 are pending in the application. No claim amendments are submitted at this time.

REJECTIONS UNDER 35 U.S.C. 102(b)

Claims 1-2 and 7-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Williams et al., J. Nat. Prod. 2002, 65, 29-31 (hereinafter "Williams").

The Examiner alleges that Williams discloses a method for the resolution of 3-aminopentanenitrile. Applicants respectfully disagree.

It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See *Motorola Inc. v. Interdigital Technology Corp.* 43 USPQ2d 1481 (1997 CAFC).

Williams fails to disclose a process for obtaining enantomerically enriched 3-aminopentanitrile from racemic 3-aminopentanitrile as recited in independent Claim 1, and therefore fails to disclose each and every element of independent Claim 1. In particular, Williams describes a method for the synthesis of (R)-3-aminopentanitrile from (R)-2-aminobutanol or (S)-3-aminopentanitrile from (S)-2-aminobutanol by a multi-step synthesis. The racemates are never mixed during this process. Accordingly, there is no racemic 3-aminopentanitrile in the process of Williams, and Williams fails to disclose each and every element of independent Claim 1.

Moreover, in order to rely on a reference as a basis for rejection of the claimed invention, the reference must either be in the field of the inventor's endeavor or be reasonably pertinent to the particular problem with which the inventor was concerned.

Oetiker, 977 F.2d at 1447; *see also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Williams takes a fundamentally different approach for preparing enantomerically enriched 3-aminopentanitrile than the process of independent Claim 1. In particular, Williams starts with (R)-2-aminobutanol, an enantomerically enriched precursor and converts this precursor into (R)-3-aminopentanitrile. There is no racemic mixture to enrich. In contrast, Applicants start with a racemic mixture of (R)-3-aminopentanitrile and (S)-3-aminopentanitrile and enrich for one or the other racemate using the process of independent Claim 1. Accordingly, one of ordinary skill in the art would not look to the teachings of Williams to provide a process for obtaining enantomerically enriched 3-aminopentanitrile from racemic 3-aminopentanitrile, and Williams cannot be considered analogous art.

With regard to the Examiner's statement regarding Example 2, page 11 of the specification, Table 2, and the synthesis of a racemate that is 50.7% ee, Applicants respectfully point the Examiner to page 9, lines 1-15 of the Application prepub where ee (R) and ee (S) determination is described. It is specifically pointed out that when the R and S racemates are equal (50% each), the ee value is 0%, and an increase in enrichment of one or the other racemate increases this number (See, page 9, lines 14-15). Therefore, a racemate with an ee (S) value of 50.7% contains 75.35 % (S)-racemate and constitutes an "enantomeric excess": Accordingly, the Examiner's assertion that the process of independent Claim 1 does not effectively separate racemates is without merit.

Accordingly, Williams fails to anticipate independent Claim 1, and the Examiner's rejection should be withdrawn. Reconsideration is respectfully requested.

Claims 2-15 either directly or indirectly depend from and add further limitations to independent Claim 1 and are deemed allowable for at least the same reasons in combination with independent Claim 1.

REJECTIONS UNDER 35 USC 112, 2ND PARAGRAPH

Claims 1-15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Examiner alleges that it is not clear what the Applicants consider an enantomeric excess. Applicants respectfully disagree.

Applicants submit that the terms enantomerically enriched and enantomeric excess are specifically defined on page 3, lines 2-9 of the Application prepub. Therefore, an enantomeric excess is a racemic mixture having an ee value (as described on page 9, lines 1-15 and herein above) of from 2 to 100%.

Accordingly, Applicants have clearly defined an enantomeric excess and respectfully request that the Examiner's rejections of Claims 1-15 be withdrawn.

It is believed that the pending claims are now in condition for allowance and notice to such effect is respectfully requested. Should the Examiner have any questions regarding this application, the Examiner is invited to initiate a telephone conference with the undersigned.

Respectfully submitted,

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